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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM A. ELMER

Appeal 2008-005182
Application 10/098,648
Patent 5,711,100
Technology Center 3600

Decided: September 30, 2009

Before WILLIAM F. PATE III, JOHN C. KERINS, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

WILLIAM F. PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

This is an appeal from the final rejection of claims 2, 3, 13-17 and 19-25 in Appellant's reissue application of U.S. Patent No. 5,711,100. Claims 1, 4-12, 18 and 26 stand allowed. These are the only claims in the

application. We have jurisdiction over the appeal under 35 U.S.C. §§ 134 and 6.

The claimed subject matter is directed to an advertising sign for magnetically mounting onto a metal panel of a motor vehicle.

Claim 2, reproduced below, is further illustrative of the claimed subject matter.

2. An advertising sign for removably mounting onto a metal panel of a motor vehicle, comprising:

an advertising member having a base, ends and sides formed together into a completely enclosed hollow body;

plural magnets; and

means for pivotally attaching each magnet to the base so that each magnet can pivot and adjust to differences in slope along a vehicle metal panel to which the advertising sign may be attached, wherein the pivotal attaching means comprises a flexible sleeve between each magnet and the base.

REFERENCES

The references of record relied upon by the Examiner as evidence of obviousness are:

Podoloff	US 3,245,165	Apr. 12, 1966
George	US 4,052,806	Oct. 11, 1997
Muggli (as translated)	EP 0 415 194	Mar. 6, 1991

REJECTIONS

Claims 13-16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 2, 3 and 19-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muggli in view of George.

Claims 13-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muggli in view of George and Podoloff.

As evidence to rebut a prima facie holding of obviousness, the Appellant relies on two affidavits by Mrs. Sharon A. Elmer, an affidavit by Paul J. Halyard, an affidavit by William A. Elmer and an affidavit by Julian C. Renfro.

ISSUES

The Examiner contends that claims 13-16 are indefinite in that the phrase “below a remaining portion of the base around each receptacle is unclear.” Therefore, the first issue for consideration is whether Appellant has shown that the Examiner erred in rejecting claims 13-16 under 35 U.S.C. § 112, second paragraph.

Appellant argues that claims 2 and 3 are not obvious from the Muggli and George references. Specifically, the Appellant argues that the magnetic assembly used for supporting the rooftop sign in Muggli does not disclose a means for pivotally attaching each magnet comprising a flexible sleeve. Appellant supplies three affidavits from William Elmer, Renfro and Halyard. These affidavits state that Muggli fails to show such a pivotal connection. With respect to claim 3, Appellant argues that the fastener of Muggli does not extend through the magnet. Accordingly, the issue for our consideration is whether Muggli and George render the subject matter of claims 2 and 3 prima facie obvious.

The final issue for our consideration is whether, if the Examiner has established a prima facie case of obviousness, the affidavits provide sufficient evidence of secondary considerations when considered with the evidence of nonobviousness to counterbalance the evidence for obviousness.

FINDINGS OF FACT

1. Muggli discloses a tetrahedral sign for placing on a metal panel of a vehicle such as a roof. See Fig. 2.
2. Muggli shows a base comprised of flat base panel 3 and hollow rectangular tubes or receptacles referred to as rails 113 and 114. The top or display portion of Muggli is composed of three sides 2 and a top point at 5. See USPTO translation, page 4, ll. 1-23 and page 6, ll. 1-18. The display sign of Muggli is attached to the roof by virtue of permanent magnets 112. The magnets are mounted on the base rail 114 via rubber sleeves 115 which have a reduced diameter middle region. The sleeve is mounted to the base rail 114 via a nut 116 held in the rail and attached to the sleeve via fastener or screw 117. It is our finding that the middle region of rubber sleeve 115 is resilient and allows the top portion of the rubber sleeve to pivot and adjust somewhat with respect to bottom portion due to the reduced diameter portion in the middle.
3. George discloses an advertising sign for removable mounting onto the metal panel of a motor vehicle, particularly a roof, in which the shape of the sign is of rectangular configuration. The sign is mounted so that the long axis of the sign is aligned with the vehicle's direction of travel.

4. Podoloff discloses magnets for mounting a sign on a motor vehicle. Podoloff discloses that the magnetic surface may be covered with rubber so that only a non-scratching material will come into contact with the supporting surface. See Col. 4, ll. 19-24.

PRINCIPLES OF LAW

“35 U.S.C. § 112, ¶ 2 requires that the specification of a patent ‘conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.’ Because claims delineate the patentee’s right to exclude, the patent statute requires that the scope of the claims be sufficiently definite to inform the public of the bounds of the protected invention, i.e., what subject matter is covered by the exclusive rights of the patent. Otherwise, competitors cannot avoid infringement, defeating the public notice function of patent claims.” *Halliburton Energy Services, Inc. v M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008) (citations omitted).

The definiteness of claim language must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *In re Moore*, 439 F.2d 1232 (CCPA 1971). *See also, In re Cohn*, 438 F.2d 989, 993 (CCPA 1971) (sustaining rejection of claims under 35 U.S.C. § 112, second paragraph, as being indefinite, where the claims were inherently inconsistent with the description, definitions, and examples appearing in applicant’s specification).

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 406-407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

ANALYSIS

Turning first to the rejection of claims 13-16 under 35 U.S.C. § 112, second paragraph, we will reverse this rejection. According to the Examiner, the phrase “below a remaining portion of the base around each receptacle” is indefinite. However, except for the conclusory statement that this phrase is unclear, the Examiner never provides a reason why one of ordinary skill would not understand the metes and bounds of the claimed subject matter. In our view, the claim is directed to a base portion with a main level that has magnetic receptacles as a part thereof that extend below the main level of the base portion. Therefore, it is our conclusion of law that the subject matter of claims 13-16 is not indefinite under the second paragraph of 35 U.S.C. § 112.

We next construe the pivotal attaching means limitation found in claim 2. Our reviewing court has established a framework to determine whether the elements of a claim evoke means-plus-function treatment. *See Al-Site Corp. v. VSI Intern, Inc.*, 174 F.3d 1308, 1318 (Fed. Cir. 1999). If the word “means” appears in a claim element in association with a function, our reviewing court presumes that § 112, paragraph 6, applies. This presumption collapses, however, if the claim itself recites sufficient structure, material, or acts to perform the claimed function. *See id.* Inasmuch as claim 2 recites sufficient structure to perform the claimed function, i.e., a flexible sleeve between each magnet and the base, it is our reasoned conclusion that the subject matter of claim 2 falls outside of § 112, sixth paragraph.

We are in agreement with the Examiner that it would have been obvious to change the pyramidal or tetrahedral shape of Muggli into a rectangular display sign for an automobile as taught by George. In our view, this is merely the combination of prior art elements according to known methods to yield a predictable result. We have previously found that Muggli discloses a base having a flat plate 3 and plural magnet receptacles--rails 113, 114--as a part of the base. Muggli further discloses plural magnets and means for pivotally attaching the magnets to the base 3, 114. It has been our finding that the reduced diameter portion of rubber sleeve 115 allows the sleeve to flex or pivot to some extent around the reduced diameter middle portion. Accordingly, it is our legal conclusion that the subject matter of claim 2 is prima facie obvious from the combined teachings of Muggli and George.

Turning to a discussion of claim 3, we note that the fastener, screw 117, of Muggli does not extend through the magnet and the flexible sleeve when the device is assembled for attachment to the vehicle roof. If the fastener of Muggli were modified to extend through the magnet and sleeve, this modification would presumably limit the flexing or pivoting about the flexible middle portion of the rubber sleeve 115. Accordingly the subject matter of the fastener extending completely through the rubber sleeve is inimical to the disclosure of Muggli, and a modification thereof would not have been obvious to one of ordinary skill. Therefore the subject matter of claim 3 would not have been obvious to one of ordinary skill in view of the teachings of Muggli and George.

With respect to claims 13, 14, and 15, we note that plural magnet receptacles i.e., receptacles that attach the magnet to the remaining portion of the base are disclosed as rails 114 in Muggli. As George teaches, it would have been obvious to place these magnetic receptacles along adjacent sides and adjacent ends of the display device when it is made rectangular as George teaches.

With respect to claim 17, we note that Podoloff teaches covering the magnet surface so that the metal finish of the vehicle is not harmed. Appellant does not argue that the rubber substance disclosed in Podoloff is not the plastic claimed in claim 17. Instead, Appellant premises the patentability of claim 17 on the patentability of claim 2. Claim 2 is prima facie obvious. Therefore, the rejection of claim 17 under Muggli in view of George and Podoloff is affirmed.

With reference to claim 16, we note that the magnetic receptacle of Muggli does not totally surround the magnet as required by claim 16. Therefore the rejection of claim 16 is reversed.

We further note that claims 19-25 depend from claim 3 and the rejection of claim 3 has not been sustained. Therefore, the rejections of claims 3, 16 and 19-25 are reversed.

Secondary Considerations

As noted above, we have found the subject matter of claims 2, 13-15 and 17 to be prima facie obvious. Whenever obviousness is found with respect to the subject matter on appeal, and Appellant furnishes evidence of secondary considerations, it is our duty to reconsider the issue of obviousness anew, carefully weighing the evidence for obviousness with respect to the evidence against obviousness. *See, for example, In re Eli Lilly & Co.*, 902 F.2d, 943, 945 (Fed. Cir. 1990). We are also mindful that the objective evidence of nonobviousness in any given case may be entitled to more or less weight depending on its nature and its relationship with the merits of the invention. *See Stratoflex Inc. v. Aeroquip*, 713 F.2d 1530, 1538 (Fed. Cir. 1983). To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore we must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986).

An expert's opinion on the legal conclusion of obviousness is neither necessary nor controlling. *Avia Group International Inc. v. L.A. Gear California Inc.*, 853 F.2d 1557, 1564 (Fed. Cir. 1988)

“ ‘Conclusory, unsupported assertions by experts as to the definition of a claim term are not useful to a court.’ *Phillips*, 415 F.3d at 1318. . . . Moreover, expert testimony at odds with the intrinsic evidence must be disregarded. *Id.* (“[A] court should discount any expert testimony that is clearly at odds with the claim construction mandated by . . . the written record of the patent.”) (internal quotations and citation omitted). That is the case here.” *Network Commerce, Inc. v Microsoft Corporation*, 422 F.3d 1353, 1361 (Fed.. Cir. 2005).

Affidavits fail in their purpose when they merely contain unsupported conclusory statements. *See In re Wright*, 999 F.2d 1557, 1563 (Fed. Cir. 1993); *In re Brandstadter*, 484 F.2d 1395, 1405 (CCPA 1973) (affidavits fail in their purpose since they recite conclusions but few facts to buttress said conclusions).

Appellant furnishes an affidavit by Patent Attorney Renfro directed to the obviousness of claims 2 and 3. As noted above, an expert's conclusion on obviousness is neither necessary nor controlling. Furthermore, to the extent that the expert Renfro testifies about the meaning of the claim term “sleeve”, such expert testimony about the definition of terms is not useful. Renfro states that member 115 of Muggli is not a sleeve, inasmuch as a sleeve is defined as a member that surrounds something else. In our view, member 115 is an empty sleeve or a sleeve surrounding an empty bore, and the member 115 clearly satisfies the definition of an empty sleeve.

Furthermore, Renfro defines the term “spatial” and states that the member 115 does not permit rocking. To the extent that “rocking” is the same as the claimed “pivoting and adjusting”, it is our view that Muggli inherently, i.e., necessarily permits pivotal movement around the reduced diameter portion. Finally, Renfro states that there is no suggestion for the combination of references. As the Supreme Court has recently noted, a strict requirement for teaching, suggestion, or motivation is inconsistent with its precedent concerning obviousness. *KSR*, 550 U.S. at 415. The affidavit of Renfro is entitled to but little weight.

We have carefully reviewed the affidavit of William A. Elmer, but the averments in paragraph 11 are not relevant to the prima facie case of obvious. The affidavit of William Elmer is entitled to but little weight.

Turning to the affidavit of Paul Halyard, Halyard states in paragraph 2 that evaluation of the obviousness of a rejection based on Muggli and George is within his background and experience. Even if Halyard is a legal expert, however, an expert’s conclusion respecting obviousness is neither necessary nor controlling. Halyard states in paragraph 5 that the rubber sleeve 115 of Muggli is likely to fail, that the sign will become unstable, and then fly off the vehicle causing a highway safety risk. According to Halyard, the structure and materials of the Appellant’s invention are much less likely to deteriorate. However, these materials are unclaimed. To the scope of the claimed subject matter, the construction of Muggli is no different than Appellant’s claimed construction.

Likewise, with respect to paragraph 6, there is no claimed subject matter that would differentiate Appellant’s invention from what Halyard

states is a resilient member bonded using glue or mold joints. Paragraph 7 of the affidavit states that the rubber sleeve 115 is not likely to function well under wind loading conditions if it is made flexible enough to provide the claimed pivotal connection. In our view, one of ordinary skill would have been able to understand the trade-off mentioned by Halyard in this paragraph and choose the durometer hardness of the rubber as a compromise between pivotal motion and wind loading. Paragraph 8 of Halyard's affidavit discusses differences between Muggli and Appellant's claimed invention. We fully credit these differences as *disclosed*. However, there is nothing in the claimed subject matter on appeal that is relevant to these argued differences. Finally, Halyard in paragraph 9, talks about the low profile of attachment of Appellant's claimed invention. A low profile attachment or the words "low profile" do not appear in Appellant's claims. Accordingly, having considered the affidavits from Renfro, Elmer and Halyard, these affidavits are entitled to but little weight.

Turning to the initial affidavit of Sharon A. Elmer, we credit the affidavit with showing that HTH has increased its sales substantially year over year. However, we are in agreement with the Examiner that the affidavit fails to provide a nexus between the claimed subject matter and the commercial success. Paragraph 7 merely has a conclusory statement that a number of the claimed features and the overall combination of features has contributed significantly to the commercial success of the invention. Turning to paragraph 8, the claims on appeal do not require a unitary base and sides completely enclosing the sign. Multiple magnets and the ability of the sign to conform to vehicle rooftops are features clearly known and

shown in the applied prior art. Therefore, the first affidavit of Sharon Elmer is entitled but little weight.

Turning to the supplemental affidavit, in paragraph 3, Sharon Elmer first includes a conclusory statement that the HTH sign is based on a combination of features recited in claims 2, 3 and 13-17. Next she paraphrases claims 2 and 3 and includes a conclusory statement that the “pivoting” and “stability” of the sign is a factor contributing to its commercial success. We find that this statement is completely conclusory. It merely paraphrases the claim language and states that this claim language is responsible for the commercial success. Affidavits fail in their purpose when they merely state unsupported conclusory statement. *See in re Wright* 999 F.2d 1557, 1563 (Fed. Cir. 1993) and *In re Brandstadter* 484 F.2d 1395, 1405 (CCPA 1973). In addition, “stability” is unclaimed. Accordingly, based on the conclusory nature of the averment in paragraph 3, the second Sharon Elmer affidavit is entitled to but little weight.

We have carefully reviewed the affidavit evidence furnished by Appellant. When we consider all of the evidence anew, it is our legal conclusion that the evidence for obviousness outweighs the evidence against obviousness. Therefore, the Examiner’s rejections of claims 2, 13-15, and 17 are affirmed.

CONCLUSIONS

The Appellant has established that the Examiner erred in rejecting claims 13-16 under 35 U.S.C. § 112, second paragraph

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The Appellant has not established that the Examiner erred in rejecting claims 2, 13-15, and 17 on the grounds of obviousness under 35 U.S.C. § 103.

The Appellant has established that the Examiner erred in rejecting claims 3, 16 and 19-25 under 35 U.S.C. § 103 as obvious.

Accordingly, the rejections of claims 2, 13, 14, 15, and 17 are affirmed and the rejections of claims 3, 16 and 19-25 are reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED-IN-PART

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